REMARKS

Claims 46-91 are pending, and claims 46-48, 70, 74, and 90 are under examination. Claims 46-47, 70, 74, and 90 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. All claims stand rejected under 35 U.S.C. § 102(b) as being anticipated by Levy et al., WO 2002/014349 ("Levy").

Amendments to the Claims

Claim 46 is currently amended to incorporate the limitations of claim 48 and to recite that the method includes administering the compounds of general formula (I) to a patient in need thereof. Claim 48 is now canceled.

New claims 92-96 correspond to the subject matter of claims 46-47, 70, 74, and 90, but proline is not recited as an allowed residue for P2 in the absence of a linker at P2 or P4. Support for these claims is found, for example, in the previously presented claims.

No new matter is added by these amendments.

Claim Rejection under 35 U.S.C. § 112, First Paragraph

Claims 46-47, 70, 74, and 90 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. These claims are directed to methods of use of compounds according to general formula (I), which has the following structure,

P4-P3-P2-P1 (I).

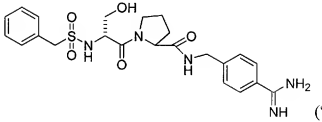
Each of the P1-P4 moieties may be unsubstituted, monosubstituted, or polysubstituted. In making the rejection, the Office asserts that the specification does not provide sufficient written description of the allowed substituents that would allow a skilled artisan to recognize all of the compounds encompassed by these claims. Claim 48, which recites

particular substituent groups for P4, P3, and P1, was free from this ground for rejection. In order to expedite prosecution, and without agreeing with the Office's assertions, claim 46 has been amended to recite the limitations of claim 48. This ground for rejection may now be withdrawn.

Claim Rejection under 35 U.S.C. § 102(b)

The Office asserts that claims 46-48, 70, 74, and 90 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Levy.

The currently amended claims are directed to a method of inhibiting plasma kallikrein and/or factor XIa and/or factor XIIa where the method includes administering a compound of general formula (I) to a patient in need thereof. In the present Office Action, and following the amendment to claim 46 previously submitted by the Applicants on December 9, 2009, the Office expanded examination to the following species,



("the examined species").

In this structure, the Office states that the benzylsulfonyl group corresponds to instant P4, the serine residue corresponds to instant P3, the proline residue corresponds to instant P2, and the 4-amidinobenzyl moiety corresponds to instant P1.

The Office further states that Levy teaches compound J in Figure 10F, which corresponds to the examined species. The Office acknowledges that Levy is silent regarding the inhibition of plasma kallikrein, factor XIa, or factor XIIa. In making the rejection, the Office asserts that the recitation of "inhibiting plasma kallikrein and/or factor XIa and/or factor XIIa" has not been given patentable weight. In the alternative, the Office also asserts that

> "even if one were to give some weight to the preamble, the claimed limitation…will inevitably flow from the teachings of Levy, since the same compound (Compound J above) is being administered to subjects (human patients in need of a decrease in urokinase activity) all of which have "plasma kallikrein and/or factor XIa and/or factor XIIa" in their cells" (page 9 of the Office Action).

For a claim to be anticipated, "each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference" (M.P.E.P. § 2131, citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 2001)). Further, when a rejection under 35 U.S.C. § 102 is made, M.P.E.P. § 2112 (IV) provides that (emphasis added):

> "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)….The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)…."

The current claims, now amended to clarify that the method is directed to treatment of patients who are in need of a decrease in plasma kallikrein, factor XIa, and/or factor XIIa activity. The Office has not provided any showings that the Levy subject who requires a decrease in urokinase activity must also require a decrease in plasma kallikrein, factor XIa, and/or factor XIIa activity. Indeed, the Office acknowledges that Levy is silent regarding the inhibition of plasma kallikrein, factor XIa, and/or factor XIIa. In the absence of the required showings, Levy cannot inherently anticipate the present claims, and this ground for rejection of claims 46-48, 70, 74, and 90, as amended, may be withdrawn.

Applicants also note that new claim 92, which does not recite proline as an allowed residue for P2, does not encompass compound J of Levy cited by the Office.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and such action is hereby respectfully requested. Applicants also respectfully request that claims 49-69, 71-73, 75-89, 91, and new claims 92-96 be examined in accordance with M.P.E.P. § 803.02.

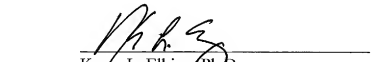
Applicants authorize the Office to charge $104.00 to Deposit Account No. 03-2095 for the fee required by 37 C.F.R. § 1.16(i) in payment of excess claims fees for the four (4) excess claims introduced with this Reply.

Enclosed is a Petition to extend the period for replying to the Office Action for three months, to and including July 5, 2011, as July 4, 2011, is a Federal holiday.

If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 24 June 2011



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